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EXAMINER

FOWLKES, ANDRE R

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,674

Applicant(s)

BOUTHORS ET AL.

Examiner

Andre R. Fowlkes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☒ Claim(s) 1-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-31 are pending.

Specification

2. The disclosure is objected to because of the following informalities:
- "mypage.html" should be – mypage.html – on p.1 paragraph 13 of the published application.

Appropriate correction is required.

Claim Objections

3. Claims 1-31 are objected to because of the following informalities: Multiple claims use commas to separate each element phrase (e.g. claims 1, 12-14, and others). Claim element phrases should be separated by a semicolon. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 recites the limitation "said code" in line 2. There is insufficient antecedent basis for this limitation in the claim. The examiner is interpreting "said code" to mean – said active code --, to examine the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 9-14 and 23-31 rejected under 35 U.S.C. 102(b) as being anticipated by Cuomo et al., (Cuomo), U.S. Patent No. 5,861,883.

As per claim 1, Cuomo discloses **a method for optimizing the looking up of a page of data looked up on a terminal** (col. 3:61-63, "The forwarding software manipulates (i.e. optimizes) the retrieved data before delivering it to the web browser"), **the looked-up data being downloaded from a first remote site and/or available on a data medium** (figure 2, and associated text, (e.g. col. 3:42-4:9)), **characterized in that it comprises a step for inserting on the fly at least one active code into said page by said terminal** (col. 3:64-67, "the web browser displays the retrieved data from the web server via forwarding software. The browser executes an applet (i.e. active code) that is embedded (i.e. inserted on the fly) by the forwarding software into the retrieved data").

As per claim 2, the rejection of claim 1 is incorporated and further, Cuomo discloses that **the area of said page wherein said active code is inserted, is determined according to the type of action generated by said active code** (col. 4:35-39, "Forwarding software may provide parameters that designate how that applet should connect to the client software. In addition, when the web page contains frames representing multiple documents that are simultaneously visible, multiple applets may be active simultaneously (i.e. the active code is located according to the type of action generated by the active code)").

As per claim 3, the rejection of claim 1 is incorporated and further, Cuomo discloses that **active code inserted on the fly is a final active code enabling an algorithm to be executed on said terminal** (col. 3:64-67, "the web browser displays (on the terminal), the retrieved data from the web server via forwarding software. The browser executes an applet (i.e. final active code) that is embedded (i.e. inserted on the fly) by the forwarding software into the retrieved data").

As per claim 4, the rejection of claim 1 is incorporated and further, Cuomo discloses that **active code inserted on the fly is an intermediate invocation active code which, when it is executed by said terminal, enables said terminal to invoke a provider of final active code, so that the terminal receives from the latter a final specific active code enabling an algorithm to be executed on said terminal** (col. 3:64-67, "the web browser displays (on the terminal), the retrieved data from the web

server via forwarding software. The browser executes an applet (i.e. intermediate invocation active code) that is embedded (i.e. inserted on the fly) by the forwarding software into the retrieved data", and the applet acts as intermediate invocation active code when it calls another final active code).

As per claim 9, the rejection of claim 1 is incorporated and further, Cuomo discloses that **active code belongs to the group comprising: script codes interpreted by a navigator, "includes" of script code interpreted by a navigator, navigator objects, codes exploiting navigator objects, applets, codes exploiting applets, and macro-instructions** (col. 3:64-67, "the web browser displays the retrieved data from the web server via forwarding software. The browser executes an applet that is embedded by the forwarding software into the retrieved data").

As per claim 10, the rejection of claim 1 is incorporated and further, Cuomo discloses that **active code inserted into said page is loaded and/or interpreted and/or executed by said terminal before, during and/or after displaying said page on said terminal** (col. 3:64-67, "the web browser displays the retrieved data from the web server via forwarding software. The browser executes an applet (i.e. active code) that is embedded by the forwarding software into the retrieved data").

As per claim 11, the rejection of claim 1 is incorporated and further, Cuomo discloses that **active code is executed in a navigator comprised in said terminal**

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(col. 3:66-67, "The browser executes an applet (i.e. active code) that is embedded by the forwarding software into the retrieved data").

As per claim 12, the rejection of claim 11 is incorporated and further, Cuomo discloses that **active code is specifically generated according to at least one criterion specific to a component belonging to the group comprising: said at least one user of said terminal, said terminal, said first remote site, said page, the Internet access provider enabling said terminal to access said first remote site, and the navigator used by said terminal** (col. 4:35-36, "Forwarding software may provide parameters that designate how that applet should connect to the client software (i.e. the navigator)").

As per claim 13, the rejection of claim 12 is incorporated and further, Cuomo discloses that **at least one criterion belongs to the group comprising: the identity of said at least one user of said terminal, the preferences of said at least one user of said terminal, the address and/or the name of the domain of the first remote site, the origin of said looked-up data, the type and/or the version of the navigator used by said terminal, the type and/or the version of said terminal, the provider of said looked-up data, and the type of access to said looked-up data** (col. 4:35-36, "Forwarding software may provide parameters that designate how that applet should connect to the client software (i.e. the type/version of the navigator)").

As per claim 14, the rejection of claim 1 is incorporated and further, Cuomo discloses that **it is used for at least one application belonging to the group:**

- **insertion into said page, of information**
- **insertion into said page, of information relating to events handled by a second remote site connected to said terminal,**
- **insertion into said page of information relating to data available on a portal related to the content of said page,**
- **provision to the user, via said page, of at least one service provided by at least one third remote site connected to said terminal,**
- **archiving of information related to the activity of the user of said terminal,**
- **change in the presentation of said data** (col. 4:35-39, "Forwarding software may provide parameters that designate how that applet should connect to the client software. In addition, when the web page contains frames representing multiple documents that are simultaneously visible, multiple applets may be active simultaneously (i.e. change the presentation of data)"),
- **censure of at least one datum among said data, and invocation of at least one second active code** (col. 3:61-63, "The forwarding software manipulates (i.e. censures) the retrieved data before delivering it to the web browser").

As per claim 23, the rejection of claim 14 is incorporated and further, Cuomo discloses that **it is used for at least one application of the type for permanently providing the user, via said page, with at least one service provided by at least**

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one fourth remote site connected to said network, and in that said active code, when it is executed by said terminal, declares said at least one service in said page (col. 3:66-67, "The browser executes an applet (i.e. active code) that is embedded by the forwarding software into the retrieved data (i.e. page)", and the applet provides access to services on remote sites on the network).

As per claim 24, the rejection of claim 23 is incorporated and further, Cuomo discloses that **said (active) code enables a menu for accessing at least one service to be implemented by the terminal** (col. 3:66-67, "The browser executes an applet (i.e. active code) that is embedded by the forwarding software into the retrieved data (i.e. page)", and the applet provides a menu, for access to services).

As per claim 25, the rejection of claim 23 is incorporated and further, Cuomo discloses that **at least one service belongs to the group comprising:**

- **simplified services for accessing information other than that contained in said page,**

- **simplified services for accessing search engines,**

- **simplified services for accessing advanced functions of a navigator**

comprised in the terminal,

- **services for monitoring external events** (col. 5:36-38, "Within this

collaborative system, the users may collaborate with each other according to whether

they are currently viewing the same page (i.e. the external events of other users/browsers are monitored”),

- simplified access to at least one service available by hand on the Internet and which requires at least that data be entered (col. 5:48-51, “Through this collaboration system, users may participate in a tour. In such a tour, when a designated leader pulls a new page into his browser, the browsers at one or more followers automatically load the same page”).

As per claim 26, the rejection of claim 23 is incorporated and further, Cuomo discloses that **at least one service is attached to at least one event belonging to the group comprising: actions on a man-machine interface, and navigation events** (col. 5:48-51, “Through this collaboration system, users may participate in a tour. In such a tour, when a designated leader pulls a new page into his browser, the browsers at one or more followers automatically load the same page”).

As per claim 27, the rejection of claim 23 is incorporated and further, Cuomo discloses that **at least one service is attached to at least one marked-up language item** (col. 5:48-51, “Through this collaboration system, users may participate in a tour. In such a tour, when a designated leader pulls a new (marked up language) page into his browser, the browsers at one or more followers automatically load the same page”).

As per claim 28, the rejection of claim 1 is incorporated and further, Cuomo discloses that **said page of data consists of at least two subpages, wherein said active code is included in each said subpage** (col. 4:37-39, "when the web page contains frames representing multiple documents (i.e. subpages) that are simultaneously visible, multiple applets may be active simultaneously (in each subpage)").

As per claim 29, the rejection of claim 1 is incorporated and further, Cuomo discloses a **system characterized in that it comprises means adapted for implementing active code insertion according to claim 1** (col. 6:39-10:5).

As per claim 30, Cuomo discloses a **device for optimizing the lookup of a page of data looked up on said device by at least one user, the looked-up data being downloaded from a first remote site and/or available on a data medium characterized in that it comprises means for inserting on the fly at least one active code into said page** (col. 3:61-63, "The forwarding software manipulates (i.e. optimizes) the retrieved data before delivering it to the web browser", and col. 3:64-67, "the web browser displays the retrieved data from the web server via forwarding software. The browser executes an applet (i.e. active code) that is embedded (i.e. inserted on the fly) by the forwarding software into the retrieved data").

As per claim 31, the rejection of claim is incorporated and further, Cuomo discloses the **optimization device according to claim 30, characterized in that it belongs to the group comprising: microcomputers, terminals for looking up data on a network, terminals for looking up data from a removable medium, and mobile terminals** (col. 3:64-67, "the (microcomputer/terminal's) web browser displays the retrieved data from the web server via forwarding software. The browser executes an applet (i.e. active code) that is embedded (i.e. inserted on the fly) by the forwarding software into the retrieved data").

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-8 and 15-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuomo et al., (Cuomo), U.S. Patent No. 5,861,883 in view of Gupta et al., (Gupta), U.S. Patent No. 6,487,538.

As per claim 5, the rejection of claim 4 is incorporated and further, Cuomo doesn't explicitly disclose that **said terminal further provides at least one cookie.**

However, Gupta, in an analogous environment, discloses that **said terminal further provides at least one cookie** (col. 4:66-67, "Another advertising scheme accesses cookies stored on individual's browsers (i.e. terminals)").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gupta into the system of Cuomo to have cookies. The modification would have been obvious because one of ordinary skill in the art would have wanted to use cookies to ensure that users have visited the same websites, in order to aid in the collaboration of multiple pc users.

As per claim 6, the rejection of claim 5 is incorporated and further, Cuomo doesn't explicitly disclose:

- **defining a profile for a user of said terminal, generating said at least one cookie depending on said profile for a user of said terminal,**
- **providing said at least one cookie by said final active code provider to said terminal, storing said at least one cookie by said terminal.**

However, Gupta, in an analogous environment, discloses:

- **defining a profile for a user of said terminal, generating said at least one cookie depending on said profile for a user of said terminal** (col. 6:24-26, "collect and store information regarding particular users in a user profile", and),
- **providing said at least one cookie by said final active code provider to said terminal, storing said at least one cookie by said terminal** (col. 4:66-67,

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"Another advertising scheme accesses cookies stored on individual's browsers (i.e. terminals)").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gupta into the system of Cuomo to have user profile cookies generated and stored. The modification would have been obvious because one of ordinary skill in the art would have wanted to use cookies to ensure that users have visited the same websites, in order to aid in the collaboration of multiple pc users.

As per claim 7, the rejection of claim 5 is incorporated and further, Cuomo doesn't explicitly disclose that **said at least one cookie is used for identification purposes**.

However, Gupta, in an analogous environment, discloses that **said at least one cookie is used for identification purposes** (col. 4:66-67, "Another advertising scheme accesses cookies (for identification purposes)").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gupta into the system of Cuomo to have a cookies used for identification purposes. The modification would have been obvious because one of ordinary skill in the art would have wanted to ensure that only authorized PC users/systems are allowed to collaborate with each other.

As per claim 8, the rejection of claim 5 is incorporated and further, Cuomo doesn't explicitly disclose that **said final active code provider takes the content of said at least one cookie into account for generating said specific final active code.**

However, Gupta, in an analogous environment, discloses that **said final active code provider takes the content of said at least one cookie into account for generating said specific final active code** (col. 5:6-10, "Based on the information retrieved from the cookies, a local advertisement (i.e. final active code), targeted to the specific user's interests is (generated and) provided").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gupta into the system of Cuomo to have the content of the cookies accounted for when generating the final active code. The modification would have been obvious because one of ordinary skill in the art would have wanted to provide users with useful, targeted information and services.

As per claim 15, the rejection of claim 14 is incorporated and further, Cuomo doesn't explicitly disclose that said active code implements the following operations:

- **search for at least one specific piece of information in said page,**
- **creation of a list of specific pieces of information found in said page,**
- **creation of an area for inserting additional information in said page,**

- provision of said list of specific pieces of information to a provider of additional information connected to said network, and

- filling said area for inserting additional information, with data provided by said information provider in response to said operation for providing said list of specific pieces of information.

However, Gupta, in an analogous environment, discloses that said active code implements the following operations:

- search for at least one specific piece of information in said page (col. 6:25-31, "(search), collect and store ... demographic information"),

- creation of a list of specific pieces of information found in said page (col. 6:25-31, "(search), collect and store ... demographic information ... the user's age, residence, credit history"),

- creation of an area for inserting additional information in said page (col. 6:32-34, "The profile information may be utilized by the proxy to conduct target advertising (i.e. creating a targeted area for insertion in to said page)"),

- provision of said list of specific pieces of information to a provider of additional information connected to said network (col. 6:32-34, "The profile information may be ... provided to a web host so that the web host may (provide additional information)"),

- filling said area for inserting additional information, with data provided by said information provider in response to said operation for providing said list of specific pieces of information (col. 6:32-34, "The profile information may be utilized

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by the proxy to conduct target advertising (i.e. creating a targeted area for insertion in to said page)").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gupta into the system of Cuomo to have the search, collection, provisioning and target marketing based on specific pieces of information. The modification would have been obvious because one of ordinary skill in the art would have wanted to provide users with useful, targeted information and services.

As per claim 16, the rejection of claim 15 is incorporated and further, Cuomo doesn't explicitly disclose that **said additional pieces of information belong to the group comprising: advertising information, annotations, complementary links to remote sites dealing with the same subject as said looked-up data, complementary links to remote sites dealing with subjects related to the subject of said looked-up data, alternative keywords, notes assigned to said first remote sites, and tables for indexing the items of said page of looked-up data.**

However, Gupta, in an analogous environment, discloses that **said additional pieces of information belong to the group comprising: advertising information, annotations, complementary links to remote sites dealing with the same subject as said looked-up data, complementary links to remote sites dealing with subjects related to the subject of said looked-up data, alternative keywords, notes assigned to said first remote sites, and tables for indexing the items of said page**

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of looked-up data (col. 6:32-34, "The profile information may be utilized by the proxy to conduct target advertising (i.e. advertising information)").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gupta into the system of Cuomo to have additional relevant pieces of advertising and searching information displayed. The modification would have been obvious because one of ordinary skill in the art would have wanted to provide users with useful, targeted information and services.

As per claim 17, the Cuomo/Gupta combination also discloses such claimed limitations as addressed in claim 15 above.

As per claim 18, the rejection of claim 14 is incorporated and further, Cuomo doesn't explicitly disclose **censuring at least one datum among said data, and in that said active code implements the following operations: search for at least one specific piece of information in said page, creation of a list of specific pieces of information found in said page, provision of said list of specific pieces of information to an information provider connected to said network, and censure of at least one portion of said data according to at least one criterion defined by said information provider in response to said operation for providing said list of specific pieces of information.**

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However, Gupta, in an analogous environment, discloses **censuring at least one datum among said data** (col. 11:11-12, “an advertisement ... is eliminated”), and **in that said active code implements the following operations:**

- **search for at least one specific piece of information in said page** (col. 6:25-31, “(search), collect and store ... demographic information”),
- **creation of a list of specific pieces of information found in said page** (col. 6:25-31, “(search), collect and store ... demographic information ... the user’s age, residence, credit history”),
- **provision of said list of specific pieces of information to an information provider connected to said network** (col. 6:32-34, “The profile information may be ... provided to a web host so that the web host may (provide additional information)”),
- **censure of at least one portion of said data according to at least one criterion defined by said information provider in response to said operation for providing said list of specific pieces of information** (col. 11:11-12, “an advertisement ... is eliminated”).

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gupta into the system of Cuomo to search for and censure certain information based on user preferences. The modification would have been obvious because one of ordinary skill in the art would have wanted to provide users only with useful, targeted information and services.

As per claim 19, the Cuomo/Gupta combination also discloses such claimed limitations as addressed in claim 15 above.

As per claim 20, the rejection of claim 15 is incorporated and further, Cuomo doesn't explicitly disclose that **at least one specific piece of information belongs to the group of information comprising: keywords, link addresses, addresses of items mentioned in said page, and information for creating said page.**

However, Gupta, in an analogous environment, discloses that **at least one specific piece of information belongs to the group of information comprising: keywords, link addresses, addresses of items mentioned in said page, and information for creating said page** (col. 6:28-30, "the information may include the websites that the user accessed, ... and any internet searches (i.e. keywords) performed by the user").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gupta into the system of Cuomo to track keywords and link addressed. The modification would have been obvious because one of ordinary skill in the art would have wanted to track user behavior in order to provide users with useful, targeted information and services.

As per claim 21 and 22, the Cuomo/Gupta combination also discloses such claimed limitations as addressed in claims 15 and 20, above.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre R. Fowlkes whose telephone number is (703)305-8889. The examiner can normally be reached on Monday - Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703)305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARF